



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Doherty, et al.
Serial No.: 10/553,554 **Case No.:** 21375YP
Filed: October 18, 2005
For: BIARYL SUBSTITUTED THIAZOLES, OXAZOLES AND IMIDAZOLES AS SODIUM CHANNEL BLOCKERS

Art Unit
1626
Authenticity is being
checked
Laura Stock
Stock
Commissioner for Patents, P.O. Box 1450,
Alexandria, Virginia 22313-1450, on the date
appearing below.
By: Charles Hsu Date: 8/14/08
MERCK & CO., INC.

Commissioner for Patents
Box Amendments
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This paper is filed in response to the restriction requirement mailed August 1, 2008 and for which a response is due on September 1, 2008. Claims 1-31 are currently pending in the application and are subject to the following restriction under 35 U.S.C. 121:

Group I, claims 1-3, 8-12, 17 and 18, drawn to products of formula I wherein HET is a thiazole ring;

Group II, claims 1, 4, 5, 8, and 15-18, drawn to products of formula I wherein HET is a oxazole ring;

Group III, claims 1, 6-8, 13, 14, 17 and 18, drawn to products of formula I wherein HET is a imidazole ring;

Group IV, claims 19-31, drawn to methods of using products of Formula I wherein HET is a thiazole ring;

Group V, claims 19-31, drawn to methods of using products of formula I wherein HET is a oxazole ring; and

Group VI, claims 19-31, drawn to methods of using products of formula I wherein HET is a imidazole ring.

Applicants elect Group I, Claims 1-3, 8-12, 17 and 18, drawn to products of formula I wherein HET is a thiazole ring, with traverse.

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35 U.S.C. 121 specifies that if two or more independent and/or distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. See MPEP 802.01. Independent generally means that there is no disclosed relationship between the two or more claimed inventions. "Distinct" means that the inventions, although related, are capable of separate use and patentably distinguishable.

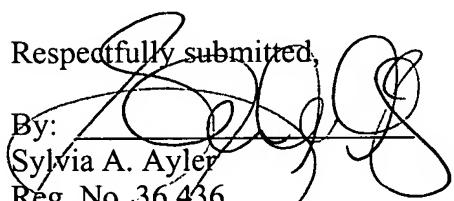
The Examiner based the restriction on the ground that the present inventions have no single general inventive concept. On the contrary, the present invention is closely related in that the compounds are sodium channel blockers used to treat pain. Thus, a search of the compounds in relation to their use would require no additional burden on the part of the Examiner to conduct the prior art search for examination of the present application in total. Regarding the method of use and composition claims, the Examiner can access information regarding these claims while searching for the compound themselves. Thus, there is minimal burden on the Examiner to examine Groups I-VI.

Applicants further request that the Examiner apply procedures for the rejoinder of withdrawn method claims consistent with MPEP 821.04 (e.g. the Official Gazette Notice (1184 O.G. 86) of March 26, 1996, and the "Training Materials for Treatment of Product and Process Claims in Light of *In re Brouwer* and *In re Ochiai* and 35 U.S.C. 103 (b)"). Applicants note that the method claims already include all the limitations of the main product claim.

As required by the Examiner, applicants further elect the compound of Example 2 as the species, and assert that claims 1-3, 8-12, and 17-31 are identified as encompassing the elected invention.

In view of the above, the Examiner is respectfully requested to withdraw the restriction requirement.

Authorization is hereby given to charge any fees which may be due as a result of this petition to Deposit Account No. 13-2755.

Respectfully submitted,

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Date: August 14, 2008